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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,042	07/19/2001	Kenichiro Matsuura	B588-021	8469

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COWAN LIEBOWITZ & LATMAN P.C.
JOHN J TORRENTE
1133 AVE OF THE AMERICAS
NEW YORK, NY 10036

EXAMINER

PRIETO, BEATRIZ

ART UNIT PAPER NUMBER

2142

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/909,042

Applicant(s)

MATSUURA ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 1954.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 99-104 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 99-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment filed 12/02/05, claims 1-98 have been canceled, and claims 99-104 remain pending and have been examined.

2. Acknowledgment is made to claim priority under 35 USC §119 for the benefit of the earlier filing date with respect to Japanese Patent Application No. 2000-222814 filed July 24, 2000. A certified copy of the application has been received and placed in file.

3. Claims terminology has been applied the broadest reasonable interpretation in light of the specification (see MPEP 2111/2106). In this case, the claimed terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the term unless the applicant provides an explicit definition for a term, in which case that definition will control interpretation of the term as it is used in the claim. Specifically, the claimed term(s)/clause(s): (i) “abstract” has been interpreted as information that has been summarized or condense; (ii) “not presentable” at the target terminal has been interpreted as information not being able to be shown, viewed or rendered; (iii) “the forwarding terminal” broadly, speaking is a storage device (e.g. a server) associated with respective conversion module, the server accessible by the target terminal, i.e. recipient (p. 12, line 25 to p. 13, line 25, and p. 16, line 6-27).

Claims 99-104 claimed terms reciting a “reception unit”, “memory unit”, “acquiring unit”, “reading unit”, “determination unit” and “generation unit” seem to lack explicit antecedent basis in view of the specification, the broadest reasonable interpretation in light of the specification will be applied to these claimed terms.

Claim Rejection under 35 U.S.C. 103

4. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

5. Claims 99-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,092,114) SHAFFER et. al. (Shaffer hereafter) in view of (US 5,862,347) Suzuki et. al (Suzuki hereafter) in further view of Kucmerowski (US 2001/0013871).

Regarding claim 55, Shaffer teach an apparatus comprising:

“reception” unit (12) for receiving information addressed to target terminal(s) (14, 16, 18) (col 3/lines 63-col 4/line 4, and claim 1, lines 35-41);

a “memory” unit (34) storing the information associated with each of the target terminals (col 4/lines 45-65, col 6/lines 31-40);

an “acquiring” unit (34) for acquiring from the information stored in the memory unit information of a target terminal to whom the received information is addressed to for performing a check and comparison function (col 4/lines 45-65), acquiring including lookup and identifying information stored in the memory unit for target terminal associated with received information (col 6/lines 31-53);

determination unit (12) configured to determine whether the transmission information at the target terminal (step 48 of Fig. 2, col 6/lines 54-65, col 1/lines 55-col 2/line 3);

generating unit (12) for generating second information from the transmission information (step 52 of Fig. 2, col 6/line 66-col 7/line 6); and

transmitting said second information to the target terminal (col 6/line 66-col 7/line 6). However, Schaffer stored capability information for each of the target terminals does not include a “displayable character” count associated with the information of each of the target terminals;

Suzuki teaches a memory unit (10) for storing information as to the number of characters which can be displayed on the display window provided at a terminal (20) (col 8/lines 30-40), including

“reception” unit (102) for receiving information to transmitted to a target terminal (col 8/lines 19-25);

a “memory” unit (10) configured with stored means for storing information and information as to the number of characters “displayable character count” which can be displayed on the display window provided at a terminal (col 10/lines 15-26, 31-38);

reading unit for reading from the memory unit for stored information thereon for generating second information from received information to be transferred to the target terminal (col 10/lines 44-50)

generating unit (105) for second “abstract” information from the received information in accordance with the information read from the read unit and transmitting to the target terminal (col 8/lines 40-53); however does not teach determining a character count associated with a message and determining that the character string to be displayed is equal to, less or greater than the characters displayable on a display

Kucmerowski teaches receiving (6) “receiving unit” information to be displayed and storing received information “memory unit” (2) [0012 on p. 2] and identifying the number of characters displayable on specific display [0012 on p. 2] and the characters required for displaying specific messages [0012 on p. 2];

determining a character count associated with a message and determining that the character string to be displayed is equal to, less or greater than the characters displayable on a display [0015-0016 & 0022].

It would have been obvious at the time the invention was made to one of ordinary skilled in the art to combine the teachings of Schaffer generating second information from transmission information when determined that the recipient display is not capable of displaying transmission information with the teachings of Suzuki for distributing information to a plurality of displays in accordance to the display capabilities. One would be motivated to utilize the teachings of Suzuki associated with transmitting information in accordance with display capabilities of the receiving display because in doing so the time for distributing said information is reduced as suggested by Suzuki. Storing the specifications, features and/or capabilities of a plurality of display including model, manufacture, size, resolution, etc. and means for retrieving any item of said information was old and well known at the time the invention was made and readily apparent to one of ordinary skill. Particularly, storing display models and/or any information for that matter corresponding to target terminals and/or their displays and accessing, retrieving and/or identifying the display model associated with target terminal was old and well known² at the time the invention was made and further be motivated to identify the display model of a receiver because in doing so the amount of data to be transmitted, e.g. the aspect ratio may be modified or blank areas deleted. One would further be motivated to utilize the teachings of Kucmerowski for transmitting information in accordance with the capabilities of the receiving display, specifically displaying information having a predetermined length on a display having different capabilities, such as the when the total characters of a message exceeds the amount of characters displayable on a particular display. One would be motivate to combine these teachings with the Schaffer system because in doing so it enables devices, e.g. having a smaller size/length that the message to be transmitted to be displayed.

Regarding claim 100, forwarding the transmission information to a destination terminal which does not require second information "abstraction" of the transmission information (Schaffer: col 2/lines 30-45, step 50 and col 7/lines 2-3); although the above mentioned prior disclosed the notification of undelivered transmission information, it does not teach notification means for notifying the target terminal of a notification representing that the transmission information is forwarded to the forwarding terminal.

Official Notice (see MPEP § 2144.03 Reliance on "Well Known" Prior Art) is taken that message arrival notification, e.g. email was old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to generate a notification message of received message, e.g. appending uniform resource locator (URL) in notification and transmitting notification

message to intended recipient. Specifically, wherein on arrival of a new message, it is stored in a server node, e.g. at a specific location in a message centre in the server node and the node embeds or appends a uniform resource locator (URL) in or to the E-mail notification message, which is to notify the recipient that a new electronic message has arrived and to identify the precise address or location of the stored message. The notification is then transmitted to the intended recipient's mailbox. Motivation would be to enable web information accessible via URLs over a network such as the Internet, because URL embedded document enable user to via one document access another document, audio, video or other multi-media information via a single click. Supportive references provided below as pertinent prior art.

Regarding claim 102, wherein said transmission is an electronic mail having attachments of different formats (Schaffer: col 1/lines 15-19).

Regarding claim 103, the “method” claim seems to comprises substantially the same limitation(s) as those discussed on the “apparatus” claims, same rationale of rejection is applicable.

Regarding claim 103, the “computer readable medium storing a control program causing a computer to execute the process” method of claim 99, seems to comprises substantially the same limitation(s) as those discussed on the “apparatus” claims, same rationale of rejection is applicable.

Response to arguments

6. Regarding new claims as presented, Applicant argues (p. 6-7 of remarks) that the applied prior art does not teach generating an abstract for transmission to a target terminal if a message exceeds the displayable count of the client.

In response to the above-mentioned argument, applicant's interpretation and/or arguments regarding the applied prior art has been considered but are moot in view of the new ground(s) of rejection.

7. Prior art both relied and not relied on teaches determining whether the character count of stored information exceeds the displayable character capability of the display device.

Citation of Pertinent Art:

8. The following prior art made of record and not relied upon are considered pertinent to applicant's disclosure. Copies of Non-Patent Literature documents cited will be provided as set forth in MPEP§ 707.05(a):

¹(US 4,503,428)

Hashimoto et. al. teaches the functions of claimed "determination unit", for determining whether the character number of stored information exceeds the displayable character capability of the display device. Specifically, a memory for storing a certain number of characters and a comparator is responsive to the number of stored characters for determining if the number exceeds a predetermined display capacity.

²(US 5,495,344)

Callaway, Jr. et. al. teaches a method and apparatus for transmitting information to a receiver. Information describing the type of display present on the selected receiver is used by the sending terminal to generate a representation of the information, which is then transmitted to the receiver, which then displays the information. The sending terminal received information to be transmitted and determines the receiver's display characteristics by correlating information identifying the receiver for which the information is intended with a database record (e.g. non-volatile programmable memory) corresponding with the identified receiver, thus establishing corresponding receiver model information. Receivers may have many different types of displays of differing sizes. The sending terminal determines the model of display present at each receiver to which a message is to be sent using the receiver information identifying the received by accessing display models associated with each receiver in a database. Particularly, display models may be stored in a database accessible by the processor 24. Since the display model of the receiver may not have the same properties as the sender or source of the information, the information may be processed by the sending terminal to generate abstract representation of the information, that uses the display of the receiver to best advantage, while minimizing the amount of data to be transmitted, e.g. the aspect ratio may be modified or blank areas deleted.

(US 4,370,645)

Cason et. al. teaches determining whether the displayable character number of a display exceeds the character number count associated with information to be displayed thereon. Specifically, generating second information from the information to be displayed when the displayable character number of the display exceeds the character number count available for display.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form (see 1.113). If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: (c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 USC 132 is outstanding, the submission must meet the reply requirements of § 1.111 (see MPEP 706.07).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Hand carried or delivered to:
Customer Service Window located at the Randolph Bldg.
401 Dulany St.
Alexandria, VA 22314

Faxed to the Central Fax Office:
(571) 273-8300 (New Central Fax No.)

Or Telephone:

(571) 272-2100 for TC 2100 Customer Service Office.

B. Prieto
Primary Examiner
TC 2100
February 24, 2006


BEATRIZ PRIETO
PRIMARY EXAMINER